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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,308	04/13/2007	Koji Hamada	SCEY 22.540 (100809-00325)	5094
26304 7590 04/14/2009 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER SHAH, TUSHAR S	
			ART UNIT 2184	PAPER NUMBER
			MAIL DATE 04/14/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,308	<b>Applicant(s)</b> HAMADA ET AL.	
	<b>Examiner</b> TUSHAR S. SHAH	<b>Art Unit</b> 2184	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

This action is in response to the Request for Continued Examination filed on January 27th, 2009.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/27/2009 has been entered.

***Status of Claims***

Claims 1-3, 5-7, and 9-14 are pending, of which claims 1, 9, 10, and 14 are in independent form.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-3, 5-7 and 9-14 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-7, 9, 10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshino et al. US Patent No. 6,761,635 B2 (hereinafter Hoshino).

**Referring to claim 1**, Hoshino discloses, a relay unit incorporated in a gaming system (game console 1, Fig. 1) and connecting one or a plurality of manipulation terminals or external storage units to an entertainment apparatus (controller 20 and remote 40, Fig. 1) having at least a first mode and a second mode as operation modes (the console operates games from CDs and DVDs in addition to playing movies from optical disks, column 4, lines 8-14);

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wherein the entertainment apparatus reads information from a recording medium, determines an operation mode based on the read information, generates an operation mode selection signal in accordance with the determined operation mode, and outputs the generated operation mode selection signal to the relay unit (when the optical disk is detected as being a DVD game, the system enters controller emulation mode, column 12, lines 20-25);

the relay unit includes: a first relay processing unit; a second relay processing unit (the game system is operable to run games from both CDROM format disks and DVDROM format disks, column 4, lines 8-12); and

a control signal generator (IOP 120, Fig. 7);

the first relay processing unit carries out relay processing for the first mode between the entertainment apparatus and the one or the plurality of manipulation terminals or the external storage units (when a DVD video game is inserted the device operates runs the game and takes input for the video game from the controller 20 and an the remote 40, column 12, lines 19-25);

the second relay processing unit carries out relay processing for the second mode between the entertainment apparatus and the one or the plurality of manipulation terminals or the external storage units (it is seen as inherent that when a CDROM video game is inserted into the console, the CDROM processing would be activated to receive input from the controller 20 and the remote 40, column 12, lines 19-25);

the control signal generator operates one of the first and second relay units to carry out the relay processing based on the received selection signal (The IOP reads out the Device IDs to the operate the device, column 11, lines 8-15); and

said the relay unit having a connector detachably connecting the entertainment apparatus and the relay unit and (controller 20, Fig.1) wherein said the first and second modes are different gaming protocols (CDROM video games and DVDROM video games, column 4, lines 8-15).

**As per claim 2**, Hoshino discloses, in at least either the case of changing from the first mode to the second mode or changing from the second mode to the first mode, a period in which neither relay processing for the first mode nor relay processing for the second mode is carried out for mode switching is provided (It is seen as inherent then when the drive tray of the console is empty, i.e. when one disk has been removed and another has yet to be inserted, the processing modules linked to the IOP would not be processing, Fig. 7).

**As per claim 3**, Hoshino discloses, the duration of the period in which neither relay processing for the first mode nor relay processing for the second mode is carried out is defined according to a communication procedure with the entertainment apparatus (The IOP determines what processing occurs when it transmits the operational mode identifier, Fig. 9).

**As per claim 5**, Hoshino discloses, the control signal generator is configured to generate a first control signal to operate the first relay processing unit and a second control signal to operate the second relay processing unit in conformity with the selection signal (The IOP determines what processing occurs when it transmits the operational mode identifier, Fig. 9).

**As per claim 6**, Hoshino discloses, the control signal generator comprises a pulse generator configured to generate pulses of a predetermined width when changing from the first mode to the second mode, or from the second mode to the first mode (the microcomputer 34 generates pulse information for digital control signals, column 12, lines 52-58).

**As per claim 7**, Hoshino discloses, the second mode is a compatible mode for insuring compatibility with other entertainment apparatuses of other models (this is seen as inherent as CDROM type games are a legacy format as compared to DVD ROM type games, column 4, lines 8-12).

**Referring to claim 9**, corresponding limitations as found in claim 1 are recited. Therefore the rejection of claim 1 applies to claim 9.

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**Referring to claim 10,** corresponding limitations as found in claim 1 are recited. Therefore the rejection of claim 1 applies to claim 10.

**As per claim 12 as dependent upon each of claims 10 and 11,** corresponding limitations as found in claim 2 are recited. Therefore the rejection of claim 2 applies to claim 12.

**As per claim 13,** corresponding limitations as in claim 3 are recited. Therefore the rejection of claim 3 applies to claim 13.

**Referring to claim 14,** corresponding limitations as found in claim 8 are recited. Therefore the rejection of claim 8 applies to claim 14.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at



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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshino.

**As per claim 11**, it is noted that Hoshino does not appear to explicitly disclose, the step of determining includes setting operation mode to the first mode when the recording medium is removed, and generating a selection signal corresponding to the first mode.

However, one of ordinary skill in the art, would recognize that as DVD video games are the more modern format and the so called normal operation mode of the instant invention, it would be obvious to default the selection of DVD processing. Further, when the system is powered on, there would generally be a default state when which would generally be the primary media format, DVD, as apposed to the legacy format, CD.

The motivation for doing so would have been that by maintaining a default state that selects the DVD processing state, the system would save switching time. A default state choosing the DVD as the default would be obvious to a designer since it is the modern format and therefore the expected input into the system. The CD support is the legacy format.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUSHAR S. SHAH whose telephone number is (571)270-1970. The examiner can normally be reached on Mon-Fri 7:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Henry Tsai can be reached on 571-272-4176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. S. S./

Examiner, Art Unit 2184

**/Henry W.H. Tsai/**

**Supervisory Patent Examiner, Art Unit 2184**